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Carmen Flosbach

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E I DU PONT DE NEMOURS AND COMPANY

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1792

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

***Advisory Action***

The Request for Reconsideration filed on May 9, 2008 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on 2/12/2008.

***Response to Arguments***

Applicant's arguments filed May 9, 2008 have been fully considered but they are not persuasive.

(A) Applicants submit that as pointed out in Applicants' previous response, page 3, lines 3-13, clearly support aliphatic polyols having 3-6 hydroxyl groups disclosing 8 different polyols. Lines 5-6 of page 3 disclose hydrogenated bisphenols and 1,4 cyclohexane dimethanol which are (cyclo)aliphatic polyols illustrating a cycloaliphatic structure. A person skilled in the art would definitely know that, for example, a cyclohexane having at least 3 hydroxyl groups can be used to form the polyester polyol used in Applicants' invention. To support a term in the claims, Applicants can not be expected to list each and every compound in existence but only need to exemplify typical compounds that can be used which has been done. Typically useful cyclic structures have been clearly shown. Applicants respectfully request that the Examiner withdraw the indefiniteness rejection under 35 U.S.C. § 112, 2nd Paragraph.

The Examiner agrees that Applicants can not be expected to list each and every compound in existence but only need to exemplify *typical* compounds that can be used which has been done. However, in contrast to Applicants argument, Applicants fail to exemplify *typical* (cyclo)aliphatic polyols having at least 3 hydroxyl groups.

Moreover, when claim recites a term *contrary to its ordinary meaning* Applicants ***are expected to clearly redefine the term***, as was discussed in paragraph 2 of the Office Action mailed on 9/10/2007. It is well settled that "Where applicant acts as his or her own lexicographer to specifically define a term of a claim *contrary to its ordinary meaning*, the written description **must clearly redefine the claim term** and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term is indefinite because the specification **does not clearly redefine the term** so

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that one of ordinary skill in the art would not understand what type of polyols are encompassed by the claimed (cyclo)aliphatic polyols having at least 3 hydroxyl groups.

(B) Applicants do not agree with the Examiner's position "a coating of Duecoffre would have the same properties as in claimed invention, since it is made from a coating composition substantially identical to that of claimed invention" (see last paragraph, page 4 of the final office action). Applicants have previously pointed out that Duecoffre's hybrid polymers are different from a simple physical mixture of a (meth)acrylic copolymer and polyester polyol of Applicants' invention. Duecoffre's clear coat contains a hybrid binder comprising polyester polyol as one part, and the (meth)acrylic copolymer as the second part and a polyester which is not the polyester (a) of the composition used in Applicants' process. Duecoffre formulates a hybrid polymeric system by forming a (meth)acrylic copolymer by free-radically polymerizing monomers in the presence of hydroxy- functional polyesters. (See Duecoffre, col. 1, lines 63-66, col. 2, lines 57-59, col. 12, Example 3 and claim 1.) Duecoffre clearly requires the (meth)acrylic copolymer to be produced in the presence of one or more of the hydroxyl functional polyesters. In contrast, the binder of the Applicants' invention is a simple physical mixture of the components. The degree of entanglement of the two different polymer chains is greater in the hybrid polymer system (Duecoffre) and the polymers may be covalently bonded in comparison to the simple physical mixture of two polymers Applicants invention. There is absolutely no evidence to support the Examiner's position that the coating compositions formed from Duecoffre's hybrid polymer composition would be substantially the same as those of Applicants' invention. Logic would dictate that since the hybrid polymers of Duecoffre are substantially different from the mixture of hydroxyl polyester and hydroxyl (meth)acrylate copolymer used to formulate Applicants' coating composition, the properties of the coatings would be substantially different.

The Examiner respectfully disagrees with this argument. As pointed out in the Examiner's Answer mailed on 4/6/2007, Duecoffre expressly teaches that a binder system comprises separate hydroxy-functional polyester in an amount of 80 % or 60 % by weight of the total amount of component B). Moreover, Duecoffre et al expressly teach in Example 5 that a binder system of the clear coat is a simple physical mixture prepared by *mixing* 32 parts of 62.6 % (20 parts of solids) solution of a hybrid binder A of Example 3 prepared by copolymerizing acrylic copolymer with hydroxy-functional polyester, and 17 parts of 70% (12 parts of solids) solution of separate hydroxy-functional polyester B) of Example 1. In the Example 6 Duecoffre et al describes a simple physical mixture of a hybrid binder A of Example 4 and polyester polyol B of Example 1. Therefore, in contrast to Applicants argument, Duecoffre's clear coat does contain a polyester polyol *in addition* to a hybrid binder of polyester polyol and the methacrylic

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acid. Moreover, **claims 11 and 12 do not recite negative limitation about a hybrid binder**, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12.

Therefore, logic would dictate that since a binder system of Duecoffre reads on a binder system of Applicants' coating composition, the properties of the coatings would be substantially identical.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.  
Primary Examiner  
Art Unit 1792

May 31, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792